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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,302	12/29/2000	Andrew Rouse	23452.127 (Formerly 52817	6724

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/750,302	Applicant(s) ROUSE ET AL.	
	Examiner Kenneth R. Coulter	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 21 – 40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33 - 64 of copending Application No. 09/885,139. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim language of the present Application (claims 21 – 40 of 09/750,302) is a broad version of the claims of Application No. 09/885,139 (claims 33 – 64; filed 3/15/05).

The differences between the claim language of present Application and Application No. 09/885,139 are minor differences that do not yield patentably distinct features.

Claim 21 in the present Application is a broad version of claim 33 in 09/885,139.

Art Unit: 2141

Claim 22 in the present Application maps exactly to claim 34 in 09/885,139.

Claim 23 in the present Application maps closely to claim 35 in 09/885,139.

Claim 24 in the present Application maps closely to claim 37 in 09/885,139.

Claim 25 in the present Application maps closely to a portion of claim 33 in 09/885,139

(Claim 33, lines 17 – 18).

Claims 26 – 40 are mapped similarly to the explanation given above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 21 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis (U.S. Pat. No. 6,076,109) (Simplified-File Hyper Text Protocol).

Art Unit: 2141

4.1 Regarding claim 21, Kikinis discloses a method of formatting content for display on a mobile wireless client device that is based on a form that is used to display content on a desktop computer, the form being associated with an action that is executable by an application, wherein the form is stored remotely from the mobile wireless client device, the method comprising:

- displaying an action menu on the wireless client device, the action menu including a plurality of action options (col. 9, lines 26 - 36);

- enabling selection of the action from the action menu displayed on the mobile wireless client device (col. 9, lines 26 - 36);

- receiving, via a wireless medium, the selection of the action from the mobile wireless client device (Abstract; Fig. 3);

- executing the action remotely from the mobile wireless client device, wherein executing the action generates content (Abstract; Figs. 3, 4);

- providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device (Abstract; Figs. 3, 4);

- formatting the content according to the mobile design element (Abstract; Figs. 3, 4; col. 10, lines 5 - 30);

- transmitting the content that is formatted according to the mobile design element to the mobile wireless client device (Abstract; Figs. 3, 4); and

- storing the mobile design element **remotely** from the mobile wireless client device in a **application digest** (Abstract; Figs. 3, 4; col. 9, lines 7 - 41).

Art Unit: 2141

4.2 Per claim 22, Kikinis teaches the method of claim 21, therein the mobile design element comprises at least one of a document style sheet, a view style sheet, a pre-formatted page, and a **script** (col. 9, lines 7 - 13).

4.3 Regarding claim 23, Kikinis discloses the method of claim 21, further comprising customizing the form according to settings selected on the wireless client device (Abstract; Figs. 3, 4).

4.4 Per claim 24, Kikinis teaches the method of claim 21, further comprising customizing the form based on at least one of a date/time setting, a language setting, a field size setting, a content size setting, and a mobile design element size setting (Fig. 3, item 101; col. 10, lines 30 - 35).

4.5 Regarding claim 25, Kikinis discloses the method of claim 21, further comprising: generating the mobile design element based on the form (Abstract; Figs. 3, 4; col. 9, lines 7 - 41).

4.6 Per claims 26 – 40, the rejection of claims 21 – 25 under 35 USC 102(e) (paragraphs 4.1 – 4.5 above) applies fully.

Art Unit: 2141

5. Claims 21 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahan et al. (U.S. Pat. Pub. No. 2002/0024536) (Method and Apparatus for Information Aggregation and Personalized Display of the Aggregated Information).

5.1 Regarding claim 21, Kahan discloses a method of formatting content for display on a mobile wireless client device that is based on a form that is used to display content on a desktop computer, the form being associated with an action that is executable by an application, wherein the form is stored remotely from the mobile wireless client device, the method comprising:

- displaying an action menu on the wireless client device, the action menu including a plurality of action options (Figs. 6, 8; paragraphs 51, 53, 70);

- enabling selection of the action from the action menu displayed on the mobile wireless client device (Figs. 6, 8; paragraphs 51, 53, 70);

- receiving, via a wireless medium, the selection of the action from the mobile wireless client device (Abstract; Figs. 6, 8; paragraphs 51, 53, 70, 115, 116);

- executing the action remotely from the mobile wireless client device, wherein executing the action generates content (Figs. 3, 4);

- providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device (Abstract; Figs. 3, 4; paragraph 115);

- formatting the content according to the mobile design element (Abstract; Fig. 3);

- transmitting the content that is formatted according to the mobile design element to the mobile wireless client device (Abstract; Figs. 3, 4); and

storing the mobile design element remotely from the mobile wireless client device in an application digest (Fig. 3, item 25; paragraphs 14, 58, 66).

5.2 Per claim 22, Kahan teaches the method of claim 21, therein the mobile design element comprises at least one of a document style sheet, a view style sheet, a pre-formatted page, and a script (Figs. 5, 7; paragraphs 52, 59).

5.3 Regarding claim 23, Kahan discloses the method of claim 21, further comprising customizing the form according to settings selected on the wireless client device (Abstract; paragraphs 51, 53).

5.4 Per claim 24, Kahan teaches the method of claim 21, further comprising customizing the form based on at least one of a date/time setting, a language setting, a field size setting, a content size setting, and a mobile design element size setting (paragraph 52).

5.5 Regarding claim 25, Kahan discloses the method of claim 21, further comprising: generating the mobile design element based on the form (Abstract; paragraph 115).

5.6 Per claims 26 – 40, the rejection of claims 21 – 25 under 35 USC 102(e) (paragraphs 5.1 – 5.5 above) applies fully.

Response to Arguments

6. Applicant's arguments with respect to claims 21 - 40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2141

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER


krc